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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,695	10/23/2003	Niles Clark	144PA0102	6634

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EXAMINER

HUYNH, KHOA D

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/691,695	Applicant(s) CLARK, NILES	
	Examiner Khoan D. Huynh	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 6,7,9-12,18-26,28-38 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8,13-17,27,39 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/23/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/23/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I (claims 1-40) and Species I in the reply filed on 02/24/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant, in the response, indicates that claims 1-9, 13-17, 27, 39 and 40 are readable on the elected species. However, upon further consideration, the claims that are deemed to read on the elected Species I are claims 1-5, 8, 13-17, 27, 39 and 40. Thus, claims 6, 7, 9-12, 18-26, 28-38 and 41 have been withdrawn from further consideration as being drawn to the non-elected inventions.

Drawings

2. The drawing, especially elected Figure 1, is objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, more than one interchangeable syringe guides as recited in claims 1 & 27, and the lid assists in retaining the syringes as recited in claim 17 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

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is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: a means for holding as recited in claims 1 & 27, a means for retaining as recited in claim 3.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5, 8, 9, 13-17, 27, 39 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is unclear what structural limitation applicant intends to cover when claim 1 calls for "one or more interchangeable syringe guides". As

understood for the elected embodiment of Figure 1, there is only one interchangeable syringe guide disclosed. Thus, the recitation of more than one interchangeable syringe guides does not have any detailed support in the specification with respect to the elected embodiment. Claims 2-5, 8, 9, 13-17, 27, 39 and 40 depend on claim 1 and are likewise indefinite.

Regarding claim 2, the recitation "said means is capable of holding different sizes of medicine vials" renders the claim indefinite since such claimed subject matter has no detailed support in the instant specification.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5, 8, 13, 14, 27 and 40, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Tetreault (5247972).

Regarding claim 1, the Tetreault reference discloses an apparatus for filling a syringe from a medicine bottle or vial (Fig. 3). The apparatus includes a means for holding (at 10) a medicine vial (at 50) and an interchangeable syringe guide (at 20) operatively associated with the means for holding. The Tetreault reference also discloses that the means for holding is made to accommodate various sized interchangeable syringe guides (col. 3, lines 1-2) for accommodating various sized syringes (col. 4, lines 27-28).

Regarding claim 2, the Tetreault means for holding is inherently capable of holding different sizes, i.e. long or short medicine vials depending on required filling amount.

Regarding claim 3, the guide (at 20) includes a means for retaining (at 19,24) the syringe when the plunger is withdrawn to fill the syringe.

Regarding claim 4, as schematically shown in Figure 2, the means for holding (at 10) includes a cavity (the inner space of element 10 extending from the first end 11 to the second end 12) in communication with the medicine vial. The cavity has an open side (at 12).

Regarding claim 5, the guide (at 20) is made of a clear plastic material to allow the user to view of syringe barrel (col. 3, lines 40-42).

Regarding claim 8, the guide (at 20) includes a longitudinal aperture (at 27) for insertion of the syringe and thereby guiding the syringe to the seal in the medical vial (Fig. 3).

Regarding claims 13 and 14, the Tetreault reference also includes a cover or lid (14) operatively associated with the means for holding the bottle or vial. The cover or lid (14) is a magnifying lens which has a magnifying feature to increase the visibility of the markings of the syringe.

Regarding claim 27, the method as claimed would inherent during the normal use and operation of the Tetreault apparatus.

Regarding claim 40, the means for retaining (at 19,24) the syringe engages the edge (Figure 3 shows edge of portion 63) of the open end of the barrel of the syringe.

8. Claims 1-5, 8, 13, 16, 17, 27 and 39, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Larrabee (3993063).

Regarding claim 1, the Larrabee reference discloses an apparatus for filling a syringe from a medicine bottle or vial (Fig. 3). The apparatus includes a means for holding (at 10,18) a medicine vial (at 14) and an interchangeable syringe guide (at 44) operatively associated with the means for holding. The interchangeable syringe guides is capable of accommodating various types, i.e. plastic-type, metal-type or glass-type syringes.

Regarding claim 2, the Larrabee means for holding is inherently capable of holding different sizes, i.e. long or short medicine vials depending on required filling amount.

Regarding claim 3, the guide (at 10) includes a means for retaining (at 46,50) the syringe when the plunger is withdrawn to fill the syringe.

Regarding claim 4, as schematically shown in Figure 2, the means for holding (at 10,18) includes a cavity (the inner space of element 10) in communication with the medicine vial. The cavity has an open side (where element 12 is insert through as shown in Figure 1).

Regarding claim 5, the guide (at 44) is made of a lead-glass material to allow observation of the amount of material in the syringe barrel (col. 3, lines 60-63).

Regarding claim 8, the guide (at 44) includes a longitudinal aperture for insertion of the syringe and thereby guiding the syringe to the seal in the medical vial (Fig. 3).

Regarding claim 13, the Larrabee reference also includes a cover or lid (12,34) operatively associated with the means for holding the bottle or vial.

Regarding claims 16 and 17, the cover or lid (12,34) assists in retaining the vial (14) and the syringe located in the guide.

Regarding claim 27, the method as claimed would inherent during the normal use and operation of the Larrabee apparatus.

Regarding claim 39, the means for retaining (at 46,50) the syringe engages the tabs (48) of the open end of the barrel of the syringe.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larrabee (as discussed supra) in view of Tetreault (5247972).

The Larrabee reference DIFFERS in that the lid does not specifically have a magnifying feature as claimed. Attention, however, is directed to the Tetreault reference which discloses an apparatus for filling a syringe from a medicine bottle or vial (Fig. 3). The apparatus includes a cover or lid (14) operatively associated with the means for holding the bottle or vial. The cover or lid (14) is a magnifying lens which has a magnifying feature to increase the visibility of the markings of the syringe. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Larrabee lid by employing a magnifying feature, in view of the teaching of Tetreault, in order to accurately observe the amount of material in the vial.

Conclusion


11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chanoch et al., Furr et al., Zolentoff et al., Norton et al., Wood et al. and Garukyan were cited to show an apparatus for filling a syringe with a vial.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa D. Huynh whose telephone number is (571) 272-4888. The examiner can normally be reached on M-F (7:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Khoa D. Huynh', with a horizontal line underneath.

Khoa D. Huynh
Patent Examiner
Art Unit 3751

HK
05/13/05